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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/820,480

04/02/2004

Claudio P. Plaza

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EXAMINER

PEFFLEY, MICHAEL F

ART UNIT

PAPER NUMBER

3739

MAIL DATE

DELIVERY MODE

06/10/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/820,480	Applicant(s) PLAZA, CLAUDIO P.	
	Examiner Michael Peffley	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2/23/2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 23, 2009 has been entered.

Applicant's drawings filed with the response of February 23, 2009 are acceptable and have obviated the objection.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moaddeb et al (6,405,078) in view of the teaching of Skalsky et al (4,844,099).

As asserted in the previous Office action, Moaddeb et al disclose the same basic catheter device as set forth in the instant application claims. The device includes a catheter body (12) having proximal and distal ends, a tip section (14) at the distal end of the catheter. The tip section includes a porous tip electrode (Abstract) and there is an irrigation tube (38) extending through the catheter and into the porous tip. The Moaddeb et al catheter is substantially identical to applicant's disclosed catheter, except the electrode is disclosed as being formed from a conductive, sintered material and the

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instant application claims call for a tip electrode having a non-conductive porous material with a conductive porous coating.

Also addressed in the previous Office action is the Skalsky et al teaching that it is known to form a tip electrode from a non-conductive porous material, then provide the non-conductive material with a conductive porous coating. This construction presents a less-expensive electrode since the majority of the electrode is comprised of an inexpensive non-conductive porous material and the conductive coating results in far less high-cost material required to make the electrode element.

To have provided the Moaddeb et al device with an electrode made from a non-conductive, porous material having a conductive, porous coating to reduce the effective cost of the device would have been an obvious modification for one of ordinary skill in the art, particularly since Skalsky et al fairly teach that it is known to create a porous electrode device from a non-conductive material having only a conductive coating on the surface.

Response to Arguments

Applicant's arguments filed February 23, 2009 have been fully considered but they are not persuasive.

Applicant continues to argue the intended use of the Skalsky et al device, in particular that the electrode surface requires substantial contact with tissue. Applicant further contends that since the Skalsky et al porous substrate is used to promote tissue ingrowth and ensure attachment to tissue, that it is improper for the examiner to fairly assert that the combination of the Moaddeb et al device with the Skalsky et al electrode

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may read on the limitation that the non-conductive porous material is “configured to avoid substantial contact with the tissue”. The examiner continues to disagree.

It is improper for applicant to assume that the Skalsky et al electrode must be used in the same manner (i.e. to attach to tissue) when combined with the Moaddeb et al reference. Skalsky et al is cited merely as a teaching of an alternative porous electrode structure known in the art. One of ordinary skill in the art would recognize that a porous electrode may be inexpensively produced if made from a cheaper substrate material (i.e. the non-conductive porous material) having only a conductive coating thereon. The skilled artisan would not be required to use such a construction in the exact same manner and would realize that any porous electrode may be fabricated in such a manner and continue to be used for its intended purpose. As such, the examiner maintains that the skilled artisan would recognize that the Moaddeb et al electrode may be made from a non-conductive, porous material and provided with a conductive, porous coating to make the device less expensive to produce. Further, the skilled artisan would recognize that any amount of the Moaddeb et al electrode element may be coated with the conductive, porous coating since Moaddeb et al does not require any type of tissue ingrowth in the use of the device. Providing the entire electrode element of Moaddeb et al with a conductive, porous coating, rather than select coated portions as specifically shown by Skalsky et al, would be an intuitive and obvious design consideration since Moaddeb et al does not require the electrode to be attached to tissue. Again, Skalsky et al merely provide the teaching of an alternative and less expensive porous electrode construction. The examiner maintains that there is

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proper motivation to combine the Skalsky et al alternative electrode construction in the Moaddeb et al device, and that one of ordinary skill in the art would clearly recognize that such a porous electrode having a non-conductive substrate may be entirely coated in the Moaddeb et al device since there is no need for the Moaddeb et al electrode to be attached to tissue.

Conclusion

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (571) 272-4770. The examiner can normally be reached on Mon-Fri from 7am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Peffley/
Primary Examiner, Art Unit 3739

/mp/
June 5, 2009